

REMARKS

Presently, claims 1, 3, 5-8, 10-18, 22-23 and 25 are pending in the application. Claim 2 has been canceled. Claims 1, 3, 12-13, 22 and 25 have been amended. Support for the amendments to independent claims 1, 22 and 25 may be found, for example, in paragraphs 10-11, 74-78 and 81-82 of the specification. Claims 3 and 12-13 have been amended to correct formal matters. Accordingly, no new matter has been added by the foregoing amendments.

Claim Rejection – 35 USC §112

The Examiner has rejected claims 1-3, 5-8, 10-18, 22, 23 and 25 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. While Applicants disagree with the Examiner's rejection, Applicants respectfully submit that the present claim amendments render the rejection under 35 USC §112 moot.

To the extent that the Examiner believes that the presently pending claims (as amended) are subject to this written description rejection, Applicants respectfully point out that to satisfy the written description requirement under the first paragraph of 35 U.S.C. § 112, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention (see MPEP § 2163(I)). For newly added claim limitations, the **MPEP requires that the specification provide support through express, implicit, or inherent disclosure** (see MPEP § 2163(I)(B)). To determine whether the specification provides express, implicit, or inherent disclosure, the MPEP dictates that the factual inquiry to be used is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as now claimed (see *Id.*). Applicants respectfully submit that the claimed subject matter is described with such reasonable clarity in the specification.

Prior Art Rejection – 35 USC §103

The Examiner has rejected claims 1-3, 5-20, 22-23 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No 5,661,516 to Carles (“Carles”) in view of U.S. Patent 5,652,615 to Bryant (“Bryant”), further in view of U.S. Patent 6,985,882 to Del Sesto (“Del Sesto”) and further in view of U.S. Patent 6,253,189 to Feezell (“Feezell”).

Carles teaches a method of providing advertisements to individual subscribers by tagging commercials with routing information and converter addresses. Carles uses a database of “smart” commercials containing embedded information identifying the categories of recipients for the message. The commercials are inserted into the data stream based on a previously created schedule.

Bryant teaches architecture for transmitting programming to customers. In Bryant, “base” and “fill” segments are transmitted concurrently to the customer. The number of fill segments transmitted in one signal is selected based on the bandwidth of the signal. Thus, four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal. Column 5, lines 4-9.

Del Sesto teaches an advertising marketplace in which a buyer may bid on particular avail opportunities. The system of Del Sesto “will display a list of avail sets by station in the selected market and will indicate the day and time, show category, daypart, demographic information...” Column 6, lines 62-64. The buyer will then “see the seller’s start price for the avail set by station, and will enter in the buyer counter the buyer’s offer for the avail set.” Column 7, lines 23-25. Thus, in Del Sesto, a seller lists all available ad opportunities and the advertisers choose to bid on one of the listed ad opportunities.

Feezell teaches a method for completing transactions for advertising time slots. The system of Feezell presents to an advertiser information about time slots, including marketing and valuation data for identifying and properly valuing a time slots that meets the buyer’s requirements. Abstract. After a transaction for a time slot is completed, the

system verifies that the broadcaster is in possession of the proper advertisement. See Fig. 6.

The combination of Carles, Bryant, Del Sesto and Feezell does not teach or suggest, “**receiving, from a plurality of advertisers**, a plurality of requests for advertisement presentation, **each request** associated with an advertisement and including a maximum bid, advertisement characteristics comprising intended target market characteristics and **minimum bandwidth requirements**...,” as recited in independent claim 1. The Examiner argues that Bryant discloses bandwidth requirements by teaching that bandwidth is available for the base and fill segments. Final Office Action, page 8. However, in Bryant, the bandwidth requirements for an advertisement are not provided by the advertiser, as in the presently claimed subject matter. In Bryant, ads are selected based on the available bandwidth such that they fit the available bandwidth in the program stream. Conversely, as recited in claim 1, the advertiser provides specific minimum bandwidth requirements for the advertisement. Advertisements will not be selected for insertion if the broadcaster cannot meet the minimum bandwidth requirements presented by the advertiser.

The combination of Carles, Bryant, Del Sesto and Feezell also does not teach or suggest, “compressing, based at least in part on the avail bandwidth, the selected targeted advertisement **such that the minimum bandwidth requirements are satisfied**.” This feature, as recited in claim 1, allows the broadcaster to take into account the quality requirements of the advertiser in presenting the targeted advertisement. Applicants were unable to find any teaching or suggestion in any cited reference, alone or in combination, of compressing the advertisement in a manner that takes into account satisfying the advertiser’s requested minimum bandwidth requirements.

Furthermore, the proposed combination of Carles with Bryant, Del Sesto and Feezell is improper. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

More specifically, Carles teaches inserting advertisements based on a previously created schedule. Bryant teaches that the number of fill segments transmitted in one signal are selected based on the bandwidth of the signal (e.g., four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal). However, Del Sesto and Feezell accept all bids without taking into account the bandwidth of the advertisements. Any winning bids in Del Sesto and/or Feezell would necessarily be fulfilled without any knowledge as to the bandwidth requirements of the advertisements and/or the available bandwidth of the corresponding avail into which the winning advertisement will be inserted. Therefore, Carles could not properly be modified by or combined with the teachings of Del Sesto and/or Feezell as the modified system would not be able to select advertisements based on the bandwidth as required by a combination of Carles and Bryant.

Applicants respectfully submit that independent claims 22 and 25 are patentable over the prior art at least in part based on reasons similar to those discussed above with respect to independent claim 1. Accordingly, independent claims 22 and 25 are believed to be allowable over the proposed combination of Carles in view of Bryant, Del Sesto and Feezell.

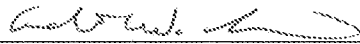
Accordingly, since the combination of Carles, Bryant, Del Sesto and Feezell is improper and does not teach or suggest all elements of the independent claims, Applicants respectfully submit that independent claims 1, 22 and 25 are allowable over the combination of Carles, Bryant and Del Sesto. Dependent claims 3, 5-8, 10-18 and 23 are allowable at least by their dependency on independent claims 1 and 22, respectively. Claim 2 has been cancelled. Reconsideration and withdrawal of the Examiner's §103(a) rejection are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejection has been overcome, and that the application, including claims 1, 3, 5-8, 10-18, 22-23 and 25 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 1/15/10

By: 

Andrew W. Spicer
Registration No. 57,420
Carlineo, Spicer & Kee, LLC
2003 South Easton Road, Suite 208
Doylestown, PA 18901
267-880-1720

Customer No.: 81712